

REMARKS

Claims 1-4, 6-10, 12-16, 18-22, and 24-47 are pending in this application. Claims 1, 7, 13, 19, 25, 30, 35, and 40 are independent claims. Claims 1-4, 6-10, 12-16, 18-22, and 24-44 are presently amended, and claims 5, 11, 17, and 23 are canceled in the foregoing listing of claims. Claims 45-47 are new claims. Reconsideration and allowance of the present application are respectfully requested.

Claim Rejections under 35 U.S.C. § 103(a) – Hall in view of Lopponen, Keating

Claims 1-4, 6-10, 12-16, 18-22, and 24-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,032,051 to Hall et al. (hereinafter “Hall”) in view of U.S. Patent Publication No. 2002/0150091 to Lopponen et al. (hereinafter “Lopponen”), and in further view of U.S. Patent Publication No. 2004/0082352 to Keating et al. (hereinafter “Keating”).

MPEP 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Additionally, the recently published “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.”, (hereinafter “KSR Guidelines”) further supports the basic requirement for a finding of obviousness as clearly articulated in the following:

To reject a claim based on this rationale, Office personnel must resolve the Graham factual inquiries. Office personnel must then articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention. “[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

The 35 U.S.C. § 103(a) obviousness rejection of claims 1-4, 6-10, 12-16, 18-22, and 24-44 is improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art must teach or suggest all the claims’ limitations or as stated in the KSR Guidelines “a finding that the prior art included each element claimed.”

Applicants’ independent claim 1 as amended, for example, is directed to sharing user information in a wireless communication network outside of a call setup, including “*sending an alert from an originator to a group communication server (GCS), the alert including presence information about the originator and requesting presence information about a target... [and] receiving information by the originator from the GCS containing information about the target in response to the alert.*” Independent claims 7, 13, 19, 25, 30, 35, and 40 have been amended to recite similar features. Applicants respectfully reassert that Hall, Lopponen, and Keating, either

alone or in combination, fail to teach or suggest at least this feature of the independent claims, as detailed below.

The Examiner acknowledges that Hall does not teach a group communication server, or communications between mobiles and a group communication server, but relies on Lopponen for teaching features of the claimed invention involving a group communication server. (Office Action, pg. 4). The Examiner alleges that Lopponen teaches a ‘group managing user 61’ equivalent to the claimed ‘originator,’ a ‘group management application (GMA) 64’ equivalent to the claimed ‘group communication server GCS,’ and a ‘user 62’ equivalent to the claimed ‘target.’ According to Lopponen, when group managing users 61 create groups, they invite users 62 to join the groups through GMA 64. GMA 64 provides the group managing users 61 a user interface with which to “create groups, define and modify group access rights, and send notifications about new groups to users.” (See paragraph [0138] of Lopponen).

However, a group managing user 61 does not send an alert to GMA 64 that includes presence information (e.g., "on," "off," "away," etc.) about itself, and GMA 64 does not request presence information about a particular user 62. A group managing user 61 merely sends information about the group it wishes to create and a list of invited participants to GMA 64. GMA 64 merely broadcasts a notification of a group to users 62, sends a group name to DNS server 24, and sends access rights information to group access rights database 65.

Paragraph [0142] of Lopponen, pointed to by the Examiner in the Response to Arguments section, states that an invited user 62 may reject a group invitation, in which case “a reject message will be sent to the group creation/management application GMA which may display it to the managing user.” Displaying to a managing user that a particular user has rejected the invitation to join his/her group does not convey presence information about the particular user to the managing user, or any other user.

In short, Lopponen deals with group lists and the creation/management thereof, not with the communication of presence information among members of a group. The Examiner has relied on Lopponen as teaching a group communication server, but the server disclosed therein (GMA 64) does not provide the functionality of the claimed group communication server as detailed above. Furthermore, the Examiner’s proposed combination in which the server of Lopponen for creating/managing group lists is used to mitigate the communications between

mobile's regarding status information is untenable as the server of Lopponen is not directed to this type of group communication nor is it disclosed as being capable of this type of group communication. Simply finding a server capable of a first type of group communication is not sufficient grounds to rely on it for performing a second type of group communication not disclosed in conjunction therewith, and violates the requirement of the KSR Guidelines quoted above for correctly determining obviousness under § 103(a) in that "each element merely would have performed the same function as it did separately."

With regard to Keating, the Examiner relies on Keating as teaching "registering at a controller that no response was received from the target." (Office Action, pg. 5). Keating is directed to controlling a group call and group call participants. In paragraph [0025] cited by the Examiner, Keating teaches a leader setting up a group call through a dispatch application processor (DAP), which queries invited participants if they would like to join the group call. If a response is not received from a particular participant, that participant is not added to the group call at that time.

Thus, even if the Examiner is correct in that Keating teaches "registering at a controller that no response was received from the target," Keating only teaches this is in the context of a call setup request and is therefore not applicable to the claimed invention. The claimed invention, in contrast to Keating, is directed to sharing user information in a wireless communication network outside of a call setup. Keating is merely directed to the creation of a dynamic group and whether a user will be added to that group. Not only does Keating fail to teach sharing user information in a wireless communication network outside of a call setup, Keating relies exclusively on the process of setting up a call to initiate operation of the disclosed DAP to query the invited participants, and is therefore not capable of performing a method of sharing user information in a wireless communication network outside of a call setup.

Accordingly, Hall in view of Lopponen and Keating cannot render as obvious, under 35 U.S.C. §103(a), Applicants' invention as presently claimed in independent claims 1, 7, 13, 19, 25, 30, 35, and 40. The nonobviousness of independent claims 1, 7, 13, 19, 25, 30, 35, and 40 also precludes the rejections of the remaining dependent claims, which depend therefrom, because a dependent claim may not be rejected as obvious if the independent claim from which it

depends is nonobvious. See *In re Fine*, 5 USPQ.2d 1596, 1600 (Fed. Cir. 1988). See also MPEP § 2143.03.

Therefore, the Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejections to claims 1-4, 6-10, 12-16, 18-22, and 24-44.

New Claims

Applicants have also added new claims 45-47 depending from claim 1, which are believed to further distinguish over the art of record.

For example, Loppenen teaches a group management application (GMA) 64 providing a group managing user 61 with a user interface to “create groups, define and modify group access rights, and send notifications about new groups to users” (see paragraph [0138]). When a new group is created, GMA 64 broadcasts a notification of the new group to users 62. Even if GMA 64 returns an indication about the group to the group managing user 61 as alleged by the Examiner, which Applicants do not admit, the indication would necessarily occur subsequent to the broadcast of the new group creation notification. In contrast, claim 45 recites the method of claim 1, “wherein transmitting the alert from the GCS to the target occurs before sending the alert from the originator to the GCS.”

Furthermore, the discussion in paragraph [0142] of Loppenen pointed to by the Examiner regarding a reject message applies only to information about a single user. In contrast, claim 46 recites the method of claim 1, “wherein the information received by the originator from the GCS is a group response message containing information about more than one target in a single message.”

Loppenen also provides no teachings regarding group communication sessions. In contrast, claim 47 recites the method of claim 1, “wherein the information received by the originator from the GCS includes an indication of which members in a given group are participating in a group communication session.”

Accordingly, these features of newly added claims 45-47 are neither taught nor suggested by Loppenen. Hall and Keating also fail to teach or suggest these features of claims 45-47.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicant submits that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Deposit Account Authorization

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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